

## **REMARKS**

Claims 22 – 37, 55 and 59 - 80 are pending. The rejection of the claims is addressed by traverse, given the attached declaration from one of the inventors swearing behind the main cited reference: O’Kane – US Publication No. 2003/0097299. Accordingly it is believed that such rejections are now moot. The rejections under 112 are also addressed. No new matter is introduced in this amendment.

### **Rejection of claims 22, 24, 25, 27, 35 and 37**

The Examiner suggests that the phrase “and/or” in the above claims renders them indefinite, apparently relying on §112(2). This rejection is traversed based on the following.

First, the recitation in claim 22 is as follows:

....(c) a first software routine executing on said first computer **and/or** said second computer, said first software routine being adapted to coordinate transfer of said digital asset to said second computer;

Applicant submits that this language is perfectly clear to one skilled in the art, particularly when taken in light of the specification. The limitation merely states that the first software routine could be executing on either or both of the first and second computers. This routine is responsible for coordinating the transfer of the digital asset to the second computer, and could include different components. As such, the routine does not need to reside in any particular physical location, a fact that the claim language expresses quite accurately and is supported in the specification. See e.g., page 21, ll. 5 – 11; “....For ease of use, the setup and transfer may be performed by either or both of such devices...” Consequently the Applicant respectfully submits that the claim as written is certainly definite.

For claim 24 the analysis is essentially the same.

For claim 25, the language states that “...at least said second computer is a portable electronics device, including a personal computer, a personal digital assistant, and/or a telephone.” As the Examiner is probably aware, many telephones today (particularly cellphones) include computers and computing capabilities. So the phrasing of the claim is believed to be appropriate and commensurate with the notion that these

devices could be separate or integrated together, and such concept would be understood by one skilled in the art from reading the claim and disclosure.

For claim 27 the language states:

wherein said second unique identifier is based on combining information from any one or more of the following: a first id for said first computer, a second id for said second computer, an asset id for said digital asset, a customer id, a randomly generated number and/or a time of said transfer.

Again the fact that all or some of these parameters may be considered in generating the second identifier is well explained in the specification: see e.g., page 18, l. 20 – page 19, l. 10; page 25, ll. 25+.

With respect to claims 35 and 37 again the specification is clear enough to explain that the content could be any or all of the forms expressed in claim 35; and that the second computer could be integrated in any or all of the environments listed (claim 37). Accordingly reconsideration is requested of these rejections as well.

#### Rejection of claims 22 - 37 and 55 in light of O’Kane

These claims were rejected under a single § 102(e) count, based on the O’Kane reference, US Publication No. 2003/0097299. This reference has an effective filing date of November 21, 2001 (“prior art date”).

To overcome this reference the Applicant has submitted the declaration of one of the inventors, Mr. Bryan Dunkeld, to explain that the invention of these claims was reduced to practice before such prior art date, and diligently reduced to practice (on December 10, 2001) beginning from at least a time immediately before such prior art date. Supporting/corroborating materials are also provided in Mr. Dunkeld’s declaration to satisfy the requirements of 37 C.F.R. 1.132.

Since no other substantive rejections are presented in the present record, Applicant submits that the claims should be passed on for allowance.

#### New claims 59 - 80

New claims 59 – 74 depend from claim 55 and should be allowed for at least the same reasons. Such claims are supported by the disclosure (see e.g., pp. 22 – 23) and/or track the language of claims 23 – 37, and therefore do not present any new matter.

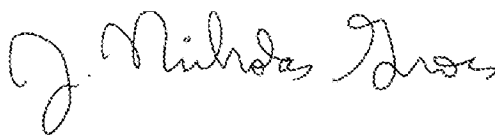
New independent claim 75 (and dependent claims 76 – 80) are directed to methods more specifically describing aspects of the assets and transactions associated therewith. These claims should be allowable for the same reasons as the claims above, and are supported by the specification at pages 23 – 24.

Conclusion

The rejections and objections from the Examiner have been addressed in detail as noted above. For the reasons set forth above, the undersigned submits that the claims should be confirmed as patentable over the references.

A petition and fee for a three month extension of time is also enclosed. Please charge any fees to deposit account no. 501-244. No additional fees are believed to be due for the new claims 59 – 80 given the number of claims previously withdrawn (1 – 22, 38 – 54, and 56 – 58). Should the Examiner wish to discuss the present case at any time, please contact the undersigned at any convenient opportunity.

Respectfully submitted,

A handwritten signature in cursive script, reading "J. Nicholas Gross".

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